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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
08 971,254	11 17 1997	PAUL J. BERLOWITZ		3889

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Exxonmobil Research and Engineering Company
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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

28

DATE MAILED: 07 26 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/97/254

Applicant(s)

BERLOWITZ et al.

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-2, 4-5, 8 and 12-30 are is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-2, 4-5, 8 and 12-30 are is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).
- ☐ Interview Summary, PTO-413

Office Action Summary

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 24, 2002 has been entered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-5, 8 and 12-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The less than about 2 wt% unsaturates limitation of claims 1 and 15 (and their dependent claims) and the less than or equal to 2 wt% olefins of claim 23 (and its dependent claims) are considered as new matter which is broader than the less than about 0.5 wt% unsaturates found in the disclosure at page 6 and claim 1 as originally filed. The "(i) at least one fraction containing primary C₁₂-C₂₄ linear alcohols" is considered as new matter which is broader than the second paragraph of page 8 that provide for "(i) at least one fraction containing

The description is defective because it does not provide description for claim 15(b) "petroleum derived hydrocarbon fraction, wherein the F-T fraction comprises at least 10% of the blended fuel", nor for claim 18 "said petroleum derived hydrocarbon boils in the range of about 250-700°F", nor for claim 19 "said petroleum derived hydrocarbon is selected from the group of raw thermally cracked distillates, hydrogenated catalytically cracked distillates and gas oils". The description found on page 7, paragraph three of the instant application provides for a description as follows".

"The product of this invention can be used as a diesel fuel, per se, or blended with other less desirable petroleum or hydrocarbon containing feeds of about the same boiling range. When used as a blend, the product of this invention can be used in relatively minor amounts, e.g. 10% or more, for significantly... to blend this product with refinery diesel streams of low quality. Typical streams are raw or hydrogenated catalytic or thermally cracked distillates and gas oils".

The above description is the only description found in the originally filed disclosure and claims of the instant application by the Examiner. The specific claimed description found in claims 15(b), 18 and 19 are considered to be new matter.

Claims 26-30 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. The adding of a C₅-500 °F fraction to the 700 °F plus F-T fraction during hydroisomerization for production of the blend boiling in the range of 250°-700 °F is critical or essential to the practice of the invention, but not included in

USPQ 356 (CCPA 1976). The disclosure at page 3, paragraphs 2-3 and the paragraph of pages 5-6 and the second and third paragraph of page 5 demonstrate that the said particular feature was considered essential by the applicant, is not reflected in the claims that are rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-5, 8 and 12-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (and its dependent claims), 5 and 15 (and its dependent claims) are indefinite for the limitation "wherein the fraction comprising the majority of oxygen (containing primary C₁₂-C₂₄ linear alcohols) is not hydro treated" because claims 1 and 15 do not provide for said fraction and claim 5 do not provide for any hydro treating in step (b) and the said phrase is redundant in step (c). Claim 22 is indefinite in that it does not further limit claim 1 and it should be canceled. Claim 28 is indefinite for the product boils in the range of C₅-600 °F that lack support in claim 27. Claim 18 is indefinite for line 2 "boils contains feeds", which is not supported by the fraction of claim 15

Claim 1 recites the limitation "wherein the fraction comprising... not hydro treated" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "wherein the fraction comprising ... not hydro

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Claim 28 recites the limitation "boils in the range of C₅-600 °F" in lines 1-2.

There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "boils contains feeds" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The prior art cited but not applied further teach Fischer-Tropsch distillate and components of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661

Examiner Medley/mn
July 25, 2002

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER